



1/28/2007 10:07

4142286881

JOHN PIENKOS

PAGE 01

TO: U.S. PATENT OFFICE  
EXAMINER JAMES ZURITA  
(571) 273-2885 (FAX)

FROM: JOHN T. PIENKOS  
APPLICANT, U.S. PAT.  
APPL. NO. 09/729,744  
(414) 228-6881 (FAX)

DATE: JANUARY 28, 2007

RE: ISSUE FEE

PAYMENT AND RELATED  
DOCUMENTS, INCLUDING  
COMMENTS ON STATEMENTS  
FOR REASONS FOR ALLOWANCE,  
312 AMENDMENT, SUPPLEMENTAL  
IDS, FORMAL DRAWINGS,  
AND CREDIT CARD FORM

(95 pages including  
cover sheet)



PTO/SB/21 (08-06)

Approved for use through 03/31/2007. OMB 0651-0031

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# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

94

Application Number

09/724,744

Filing Date

11/28/00

First Named Inventor

JOHN T. PIENKOS

Art Unit

3625

Examiner Name

JAMES H. ZURITA

Attorney Docket Number

-

## ENCLOSURES (Check all that apply)

- ☐ Fee Transmittal Form
- ☐ Fee Attached
- ☒ Amendment/Reply 312 Amendment
- ☐ After Final
- ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☒ Information Disclosure Statement including petition and fee
- ☐ Certified Copy of Priority Document(s)
- ☐ Reply to Missing Parts/Incomplete Application
- ☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53

- ☒ Drawing(s) Formal Drawings (9sh)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation
- ☐ Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) \_\_\_\_\_
- ☐ Landscape Table on CD

- ☐ After Allowance Communication to TC
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
- ☐ Proprietary Information
- ☐ Status Letter
- ☒ Other Enclosure(s) (please identify below):

Remarks

Additionally, the Applicant is submitting: 1) Issue Fee Transmittal  
2) Credit Card Payment Form Authorizing Payment of Issue Fee and IDS Fee  
3) Comments on Statements for Reasons for Allowance

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

Signature

Printed name

Date

JANUARY 28, 2007

Reg. No.

## CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature

Typed or printed name

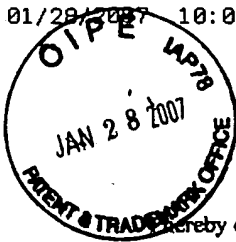
JOHN T. PIENKOS

Date

1/28/07

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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I hereby certify that this correspondence is being faxed to Examiner James Zurita at the U.S. Patent and Trademark Office at (571) 273-2885 on the following date: JANUARY 28, 2007

*J. Pienkos*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Pienkos, John T.  
Serial No.: 09/724,744  
Filed: November 28, 2000  
For: METHOD AND SYSTEM FOR FACILITATING THE TRANSFER OF INTELLECTUAL PROPERTY  
Grp. Art Unit: 3625

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COMMENTS ON STATEMENTS FOR REASONS FOR ALLOWANCE

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The Applicant appreciates the allowance of the present Application as indicated by the Notice of Allowance mailed on January 17, 2007. In response to the Notice of Allowance, the Applicant is submitting herewith the Issue Fee Payment, along with formal drawings to be used in publication of the issued patent. Also, the Applicant is submitting herewith an Amendment in accordance with 37 CFR 1.312 to make certain minor changes to the claims, and entry of these amendments is respectfully requested.

Further, the Applicant is submitting herewith a Supplemental Information Disclosure Statement. The Applicant respectfully requests consideration of the references included with this submission. The Applicant also notes with appreciation the Examiner's consideration of the references submitted in the additional Supplemental Information Disclosure Statement faxed to the Patent Office by the Applicant on 1/10/07, as indicated in the documentation accompanying the Notice of Allowance.

In addition, the Applicant has reviewed the Reasons for Allowance set forth on pages 10-12 of the Notice of Allowability accompanying the Notice of Allowance, and has the following comments in response thereto:

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Comments on Statements for Reasons for Allowance  
Submitted on January 28, 2007

- 1) During the Examiner's Interview of January 12, 2007, the Examiner indicated that he had performed additional searching in relation to the present Application. In particular, the Examiner indicated that he had reviewed, in addition to certain non-patent prior art literature, the website of MPEG LA (at [www.mpegla.com](http://www.mpegla.com)). Also, the Examiner indicated that he had conducted searching at the "Wayback Machine" at [www.archive.org](http://www.archive.org) and not identified any relevant prior art, particularly in relation to the MPEG LA website. The Examiner suggested that the Applicant make mention of these points in the present Comments.
- 2) It is also the Applicant's understanding, based upon the January 12<sup>th</sup> Examiner's Interview, that the Examiner has considered all of the information provided in the other 16 Information Disclosure Statements submitted (prior to the present submission) during the pendency of the present Application, as were listed in the Applicant's December 19<sup>th</sup> Amendment.
- 3) An additional brief Examiner's Interview occurred on January 23, 2007, subsequent to the Applicant's receipt of the Notice of Allowance. During this Interview, the Applicant indicated an intent to file the present Comments, the aforementioned Amendment in accordance with 37 CFR 1.312, as well as the further Supplemental Information Disclosure Statement being submitted herewith. Further, certain issues pertinent to the Reasons for Allowance were also discussed, which the Applicant believes can be summarized as follows:
  - a) As discussed, the Applicant does not disagree with the characterization that, at least with respect to the allowed claims of the present Application, the Applicant's invention relates to an intermediary that interacts with different parties "at arms' length" as set forth on page 12 of the Notice of Allowability. At the same time, the Applicant wishes to note that it should be understood that an intermediary that interacts with different parties on an arms' length basis can still be within the scope of the allowed claims even if the intermediary also happens to further interact with additional parties on a non-arms' length (e.g., closer) basis.
  - b) As discussed, the Examiner's determination that the present claims are allowable does not depend upon the assumption that the prior art fails to show an intermediary that buys or otherwise obtains interest(s) in patent asset(s) and also sells or otherwise provides interest(s) in those patent asset(s) at arms' length, and the Applicant is not representing for purposes of obtaining allowance of the present claims that the present Application, as of its

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priority date, necessarily provides the earliest disclosure of such an entity (at the same time, the Applicant is not admitting here that such an argument cannot be made). Rather, as indicated by the Examiner, the Examiner's position is that the Applicant's allowed claims are allowable regardless of whether such an entity is shown in the prior art, for one or more reasons including, for example, the recitation in the claims of one or more particular method steps, and/or the recitation in the claims of web-related and/or computer-related functionality.

4. Although at least some embodiments of the invention pertain to a type of intermediary that can be referred to as an "intellectual property investment bank" that has "numerous interactions with many different parties at arms' length" as stated in the Reasons for Allowance, the Applicant submits that not every allowed claim should be construed as requiring these features. Rather, aside from certain of the allowed dependent claims that expressly recite an "investment bank" (e.g., claims 69 and 77) and/or additional transfers involving additional parties other than merely first and second parties (e.g., claim 69), the Applicant submits that the other allowed claims (including the allowed independent claims) that do not expressly recite these features should be construed as broadly as possible in accordance with the language of those claims, while preserving the validity of those claims, so as to potentially encompass embodiments that do not involve either of these features. Further, the present claims should not be precluded from encompassing an intermediary that, in addition to operating as (or having a division, subsidiary, or affiliate that operates as) an intellectual property investment bank also operates (or has a division, subsidiary, or affiliate that operates) in other capacities as well (e.g., operates as an exchange).

5. The allowed independent claims 59, 76 and 78 of the present Application are intended to encompass a variety of embodiments of the invention as is consonant with the language of those claims as well as the dependent claims of the Application. As such, none of the independent claims is intended to be limited merely to embodiments in which all of the features (a)-(i) of the respective claim are performed by way of the web and/or by way of a computer system. Rather, each of the independent claims is intended to encompass a variety of different embodiments that involve or do not involve the web and/or a computer system to varying degrees (e.g., various embodiments in which any one or more of the features (a)-(i) or portions of those features involve the web and/or a computer system) as is consonant with the


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Submitted on January 28, 2007

language of the claims, the doctrine of claim differentiation, and preserving the validity of the claims.

6. Although pertinent to the claims of the present Application, none of the comments provided above are intended to prejudice or limit the Applicant's pursuit of additional claim coverage in any future continuing applications.

The Applicant appreciates the Examiner's allowance of the present Application and respectfully requests issuance of the patent based upon the Application. The Applicant also requests that the Examiner contact the Applicant at the telephone number listed below if any further discussion with the Applicant is required.

Respectfully submitted,

Dated: 1/28/07 By:   
John T. Pienkos  
(414) 228-6881



I hereby certify that this correspondence is being faxed to Examiner James Zurita at the U.S. Patent and Trademark Office at (571) 273-2885 on the following date: January 28, 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Pienkos, John T.  
Serial No.: 09/724,744  
Filed: November 28, 2000  
For: METHOD AND SYSTEM FOR FACILITATING THE TRANSFER OF  
INTELLECTUAL PROPERTY  
Grp. Art Unit: 3625

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SUBMISSION OF FORMAL DRAWINGS

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Commissioner for Patents  
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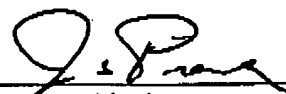
Dear Sir:

Enclosed herewith are nine (9) sheets of formal drawings for the above-identified patent application. The formal drawings reflect the amendments to the drawings submitted in the Applicant's Supplemental Amendment faxed to the Patent Office on December 30, 2006. Applicant submits that these formal drawings do not add new matter. Entry of the formal drawings in the publication and issuance of the application is respectfully requested.

If any questions should arise with respect to the submitted figures, the Examiner is urged to contact the Applicant at the phone number listed below.

Respectfully submitted,

Date: 1/28, 2007

  
John T. Pienkos  
Applicant  
(414) 228-6881